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MAYER BROWN LLP P.O. BOX 2828 CHICAGO, IL 60690			EXAMINER GISHNOCK, NIKOLAI A	
			ART UNIT 3715	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/822,426	<b>Applicant(s)</b> DEANE ET AL.	
	<b>Examiner</b> NIKOLAI A. GISHNOCK	<b>Art Unit</b> 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7,8,10,12-15,20-25,28-30,33,35-37,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7,8,10,12-15,20-25,28-30,33,35-37,40 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

In response to Applicant's remarks filed 1/21/2009, claims 1-6, 9, 11, 16-19, 26, 27, 31, 32, 34, 38, & 39 are cancelled. Claims 7, 8, 10, 12-15, 20-25, 28-30, 33, 35-37, 40, & 41 are pending.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 22-25 & 28-30 are rejected under 35 U.S.C. §101 as being directed to nonstatutory subject matter. The claims fail to produce a tangible effect. The requirement to be tangible is for the claim to produce a real-world result or beneficial product. The claims fail because they merely evaluate abstract functions and do not bring about a substantial application. The limitations do not cause an output or other indication *to a user* that something has occurred. The limitation of "outputting an assessment item" fails to provide a tangible output because the output may be to a database other intangible medium. If the claim does not entail transformation of an article, then the claim shall be reviewed to determine that it produces a useful, tangible, and concrete result. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, or concrete, but rather on whether the final result achieved by the claimed invention is useful, tangible, and concrete. If the claims are found not to have such a practical application, then the claim is determined to be nonstatutory. See MPEP 2106.

3. Claims 7, 8, 10, 12-15, 22-25, 28-30, 33, & 35-37 are rejected under 35 U.S.C. §101. In order to be considered patent eligible, a claimed process must contain sufficient ties to a machine, article of manufacture or a composition of matter. *In re Comiskey*, 84 USPQ2d 1670

Art Unit: 3715

(Fed. Cir. 2007). When an abstract concept has no claimed practical application, it is not patentable. The Supreme Court has reviewed process patents reciting algorithms or abstract concepts in claims directed to industrial processes. In that context, the Supreme Court has held that a claim reciting an algorithm or abstract idea can state statutory subject matter only if, as employed in the process, it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter. In the instant case, only a nominal recitation is claimed in the preamble for implementing the method; thus the claimed method seems to be a series of purely abstract mental steps. In this instance, the computer is not claimed to perform the steps of the invented method, and, as admitted in Applicant's remarks filed 1/21/2009, see page 2, lines 6-15, it is apparent that a user such as an educational assessor may be performing some or all of the claimed steps using a computer; thus the claims are interpreted to not require that an apparatus perform the steps.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 3715

6. Claims 7, 8, 10, 12, 13, 20-25, 28-30, 33, & 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweitzer, in view of Bloom et al. (US 5,597,312), hereinafter known as Bloom.

7. Sweitzer discloses a method of automatically generating an assessment item, the method comprising: receiving one or more inputs from a user (using an editing window, the user selects the problem type (e.g., multiple choice, free response) and lays out the elements of the problem with menu and dialog choices, 9:61-63); generating one or more variables based on the one or more inputs (Variables are used as elements of mathematical expressions, and as substitution string place holders. Whenever an instance of one problem is generated (e.g., for preview in the authoring tool or rendering by the print engine), values are computed for each of the variables according to the variation rules and these values are substituted in the text or in the mathematical expression, 11:22-29). What Sweitzer fails to explicitly teach is determining one or more relationships between at least two of the variables; and generating an assessment item based on the one or more variables and the one or more relationships [Claims 7 & 20], and wherein the one or more relationships comprise relationships based on one or more of word order; word choice; word format; sentence structure; grammar; and language [Claim 8].

However, Bloom teaches a method and system for authoring intelligent tutoring, including an exercise function (an exercise function supports trainees working through typical conversations where the goal is to handle some customer request, 6:4-12), using a grammar builder to define situations, actions and other grammar nodes and a sequence and condition of their execution for a tutoring conversation (authoring system and teaching parameters editor themselves comprise conversation knowledge and instructional strategy functions, respectively, designed to support the instructions delivered by tutor. The conversation knowledge function enables instructional designers and domain experts to build knowledge bases of conversations for use

Art Unit: 3715

by the exercise function of the tutor. The instructional strategies function enables instructional designers to adjust the parameters which the tutor uses to make its tutoring decisions, 5:58-61). The situations and actions are variables defined and linked by the user (the grammar builder is a graphical tool for building and editing discourse grammars. The author would be presented with another set of graphical tools designed to support the building of situation-action rules embedded within the top level grammar object. This would include tools for defining and linking situations and actions, identifying their type and the type of branch created downstream, and inputting feedback and false responses associated with those rules, 19:36-53). The author of an assessment item having variables, as in Sweitzer, would use Bloom's authoring system to define the relationships between those variables (referred to as parameters by Bloom) and generate the assessment item based on the relationships (in the fashion that the conversations of Bloom are generated), in order to support an item naturally in a language. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have defined the variables of the word problem generator of Sweitzer using the grammar node relationships as taught by Bloom, in order to train a student using natural language [Claims 7, 8, & 20].

8. Sweitzer discloses wherein the assessment item is a mathematical word problem and outputting an assessment item (system for formatting and printing an examination having one or more mathematical expressions, 5:20-29; It is further evident from Figure 3, Items 40 & 42 that the words, "Add two simple fractions without reducing. Add: 'A'/7 + 'B'/14" is a mathematical "word" problem) [Claims 7, 10, 20-22, 35, 40, & 41].

9. What Sweitzer and Bloom fail to explicitly teach is wherein the assessment item includes at least one of a distance-rate-time, interest rate computation, taxation, production, physics problem, or a fuel-efficiency problem [Claims 7, 10, 20-22, 35, 40, & 41]. However, merely

Art Unit: 3715

changing the type of problem generated by Sweitzer and Bloom is an issue of non-functional descriptive material (i.e. printed matter) without a new and unobvious functional relationship with the substrate, and is thus not given patentable weight. See MPEP 2106.01. The mathematical word problem generated as taught by Sweitzer and Bloom is a mere arrangement of data.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, for the assessment item taught by Sweitzer and Bloom to be one of a distance-rate-time, interest rate computation, taxation, production, physics problem, or a fuel-efficiency problem, in order to provide a larger variety of assessment items to users taking an assessment [Claims 7, 10, 20, 21, 22, 35, 40, & 41].

10. Sweitzer discloses a method of automatically generating an assessment item, the method comprising: receiving one or more inputs pertaining to the format of an assessment item, and determining a format for the assessment item (authoring tool allows {users to} change between answer formats without loss of information already entered, 10:46-51) and selecting one or more variables for use in the assessment item (variables may be replaced with numbers, text, graphics, or mathematical expressions, 12:30-32); [Claims 10 & 21]; What Sweitzer fails to teach is wherein the format of the assessment item comprises at least one event; wherein each variable is assigned to an event; determining a relationship between variables assigned to an event; and generating an assessment item based on at least the format for the assessment item and the relationship between variables assigned to the at least one event [Claims 10 & 21].

However, Bloom teaches action definitions used in the grammar builder (Action definitions are defined in terms of the following attributes: (i) a comment which is an area for comment by the authors; (ii) a text which is the actual action definition or correct response expected from the trainee; (iii) a type which identifies the type of situation; (iv) a feedback which is a specific feedback to present to the student should their response be incorrect; and (v) a false response

Art Unit: 3715

which is a specific response to be used as distracters when presenting the trainee with multiple choice options. The text attribute can be in the form of text spoken by an expert CSR, the correct answer textually presented to the trainee or specific application commands, again depending upon the identifier in the type attribute, 19:6-14), which are linked in a relationship by the author using the grammar builder (19:48-53). The situation definitions are understood to be actions, as they define situations presented to a user in natural language for the user to solve. The situation definitions are defined terms of attributes (18:65-67). The attributes {parameters} of Bloom are understood to be variables assigned to the event; the assessment items {conversations} are generated based on the relationships between the variables {such as the correct response expected or distracters}. The grammar builder is understood to define the format of the assessment item {conversation}, e.g. a syntax which defines the specific situations, actions, and other grammar nodes, and a sequence and/or conditions of their execution, 18:61-64). The variables of Sweitzer, used to generate mathematical word problems as in Sweitzer, would be formatted into natural language events by the grammar builder of Bloom, where the variables as in Bloom are assigned to the events, and the item is generated based on the relationships between the variables, as in Bloom, for the purpose of defining a situation or action definition {an event} in natural language for a user to clearly understand the problem. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have defined the word problems generated as taught by Sweitzer, using the events and their relationships as taught by Bloom, in order to train a student using natural language [Claims 10 & 21].

11. Sweitzer discloses wherein determining a relationship for the variables assigned to each event comprises one or more of the following: determining a variable for which to solve for each event ("WHAT IS THE TOTAL PRICE OF 'APPLES' APPLES IF THE PRICE OF EACH IS



Art Unit: 3715

'PRICE' ?"; "KEY: \$'TOTAL'", Figure 5) and determining an answer for each event ("WHAT IS THE TOTAL PRICE OF 2 APPLES IF THE PRICE OF EACH IS \$0.20 ?"; "KEY: \$0.40", Figure 5); determining a value for one or more variables (Variables may be replaced with numbers, text, graphics, or mathematical expressions, 12:30-32); and determining a variable format (The authoring tool allows problems to be changed between answer formats without loss of information already entered. Users may select a multiple choice format with two to five candidate answers or distracters, one of which is correct; a true/false format; or a free response format, where an exam taker writes an answer long hand. In the multiple choice format, distracters have diagnosis information attached, 10:46-51) [Claim 12].

12. Sweitzer discloses wherein determining a format for the assessment item comprises: determining a problem format having one or more sections (multiple-choice format, 10:46-53; the plurality of choices are understood to be sections); and determining content to place within each section (the variation rules engine processes the variation rules from a {multiple-choice} problem from the top down, and each line specifies a calculation, constraint, or an external function call, 17:43-51) [Claim 13].

13. Sweitzer discloses a method of automatically generating an assessment item, the method comprising: receiving one or more input parameters (The authoring tool and print engine, discussed in greater detail below, use variation rules which are stored in the variation rules module or engine and define instances of a generalized problem. The variation rules associated with a given problem guide the replacement of variables incorporated in each problem, 12:30-32); generating a document structure based on the one or more input parameters (The print engine reads worksheets and problem books. Further, the print engine sequences through multiple students; question, answer, and key sheets for each student; and the problems on each sheet. It then evaluates the random variations in the problem, stores key

Art Unit: 3715

values for later use in scoring, and arranges the problems and annotations on an output, which is either a printed sheet or a visual display on the video monitor, 18:33-40; inputs are the random variables in the problems) [Claims 22 & 40]. What Sweitzer fails to teach is producing a logical schema using the document structure; and generating an assessment item based on the logical schema [Claims 22 & 40]. However, Applicant defines a “schematic logical representation” as information contained in a file pertaining to the syntax and vocabulary used to generate natural language for a given assessment item, defining one or more variables for which text may be generated (Page 8, Para. 0038). Bloom’s conversations are taught to be syntactically-correct sequences of situations and actions, which form a variable path through the discourse. Bloom also explains that the conversations help to overcome the limitations of natural language understanding (8:45-56); in that a user selects a naturally organized response they can understand rather than a symbolic response that may be misinterpreted. The conversation mapping of Bloom is understood to represent a logical schema, *as defined by Applicant*, having information {commands, text, audio, branches, and rules} stored in a file {reusable nodes in a course} pertaining to the syntax and vocabulary {syntactically-correct conversation sequences} and defining variables for which the text may be generated {branching in the conversation is based on customer information} used to generate natural language (Conversations are syntactically correct sequences through discourse grammar made up of sequences of situation-action rules. Each abstract situation and action in a conversation sequence is instantiated with specific information in the form of application commands or information, or text with accompanying audio. Conversations are grouped together to reflect different types of scenarios that could occur between a caller and a CSR. Branches within conversations are based on customer information. Situation-action rules that are conceptually related map onto discourse grammar nodes. These nodes are reusable portions of

Art Unit: 3715

conversations that can appear in several different conversation scenarios. A course has a title, list of topics, a list of grammars, a list of activities (situations or actions), a list of conversations (subsuming text, audio, and application communication) and a list of application specifications; a grammar is a set of conversations in an AND/OR tree, where nodes are situation-action pairs, and branches are different possibilities based on the customer situation, all at 15:18-62). The logical schema of Bloom would be used to format the assessment items of Sweitzer in natural language. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the conversation generator as taught by Bloom, in the word problem generator of Sweitzer, in order to generate word problems that follow natural language [Claims 22 & 40].

14. What Sweitzer further fails to explicitly teach is wherein generating a document structure comprises: building a mental model; and outlining the document structure based on the mental model [Claim 23], and wherein building a mental model comprises: selecting one or more semantic frames; generating a list of one or more events; and binding one or more variables across the one or more events [Claim 24], and wherein outlining the document structure comprises: generating one or more sentences for the mental model; determining a function for each sentence; and determining information to express in each sentence [Claim 25]. However, Applicant defines a “mental model” as a structure with a limited number of component entities and relationships, varying along some dimensions (Page 9, Para. 0040), and a “semantic frame” as a method of organizing verbal content, making it possible to analyze a type of problem and isolate a series of variables (Page 8, Para. 0036). Bloom teaches a student model (student model is essentially a dynamic data structure that maintains a “model” of each trainee within and across training sessions. Student model is used to actively assess the trainee's mastery of the learning materials, represent the trainee's progress through the learning materials and

Art Unit: 3715

recommend topics or conversations the trainee needs to study or practice, select and present instructional interventions at appropriate levels of understanding, apply selected instructional strategies during contact rehearsals, and provide the trainee with performance feedback; 11:25-12:65), which outlines the topics taught to the student, and represents all the tasks and conversations available to the student within each topic (student model represents contact scenarios in a hierarchical network, with scenarios in major topics at the highest level, and individual conversation activities at the lowest level. Action can be verbal (i.e., responses by the CSR to the customer or to service order software output), operational (i.e., commands or data entered into the service order software by the CSR), or cognitive (i.e., information gathering, information processing and decision making). The top level is referred to as the scenario or topic node level and represents all of the possible conversational scenarios in which the CSR can engage. The second level is referred to as the task or sub-topic node level and represents all of the major tasks or parts of conversations within each scenario or topic. The lowest level, previously described, is referred to as the action node level and represents the individual actions available to the trainee, 11:52-12:4; see also 19:65-20:29). The student model of Bloom is understood to represent a mental model, *as defined by Applicant*, in the processes of building the mental model {representing the trainee's progress through the learning materials and making representations of topics the trainee needs to practice}; selecting semantic frames, *as defined by Applicant* {the hierarchical nature of the student model is organized verbal content; the branching nodes of the topic, conversation, and action levels allow selection of variables for a given problem type}; generating a list of events {the verbal, operational, or cognitive actions available to a student}; binding variables across events {the event variables are those stored in the data structure of the student model; application descriptions include information about input and output fields and the values expected in them, 16:9-13}; and outlining the document

Art Unit: 3715

structure based on the mental model {the node levels represent all the parts of the conversations used to generate a dialog}. Thus the conversations of Bloom are generated using the student model, and the conversations used to build a document structure using the user interface (Student model comprises a dynamic representation of the student's state of knowledge. The user interface comprises a communication channel between the tutor {software} and the student, 4:17-20). The student model of Bloom, containing the progress of the student as well as the variables and relationships used to generate assessment conversations by the tutor software, would be used to generate the mathematical word problems in the assessment item generator of Sweitzer. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the mental models as described by Bloom, in the word problem generator of Sweitzer, in order to reflect natural language in the word problem [Claims 23-25].

15. Sweitzer discloses storing the document structure in a file (The authoring tool stores problem descriptions in files, 9:52-53). What Sweitzer and Bloom fail to explicitly teach wherein the document structure file is an XML file. However, Applicant has not disclosed that having the file be an XML file solves any stated problem or is for any particular purpose. Moreover, it appears that the Microsoft Word type files of Sweitzer (3:52-61) or the Applicant's instant invention would perform equally well for storing a variable document specification. Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have modified Sweitzer and Bloom to use an XML file, because such a modification would have been considered a mere design consideration, which fails to patentably distinguish over Sweitzer and Bloom.

16. Sweitzer discloses wherein the document structure includes an outline of a sequence of one or more sentences for the assessment item (The authoring tool and print engine use

variation rules which are stored in the variation rules module or engine and define instances of a generalized problem. The variation rules associated with a given problem guide the replacement of variables incorporated in each problem. Variables may be replaced with numbers, text, graphics, or mathematical expressions. The variation rules for a problem are an ordered list of definitions and constraints expressed in a simple language. The variation rules may assign substitution variables (variables used in the problem layout) or temporary variables (variables used only within the variation rules). The variation rules may also impose constraints on the relationship between variables, 12:25-67; definitions and constraints are in a simple language, understood to be simple sentences; also, dynamic problems are varied using sequencing and randomization, and the sequencing and randomization functions keep historical information to avoid problem repetition, 15:48-65) [Claim 28].

17. What Sweitzer further fails to explicitly teach is wherein producing a logical schema comprises: outlining a sentence structure for one or more sentences; and determining an information format for each sentence [Claim 29], wherein determining an information format comprises determining an ordering of one or more elements for each sentence [Claim 30]. However, Bloom teaches wherein producing a logical schema comprises: outlining a sentence structure for one or more sentences (situation-action rules map onto discourse grammar nodes, the nodes are reusable portions of conversations that can appear in different scenarios, 15:54-57); and determining an information format for each sentence (Discourse grammar defines abstractly a set of possible discourses using an RTN {a recursive transition network; defining the structure of a grammar}. RTN formalism permits a discourse to be decomposed into grammars that describe specific sub-discourses for readability and reuse. Discourse grammar is a collection of grammars of which one is the top level grammar. An individual grammar definition preferably includes a name, a nickname, author comments about the grammar, a context

Art Unit: 3715

describing the purpose of this part of the discourse to a student, a list of topics that this grammar covers, a syntax defining the paths, the list of activities used by the grammar, the grammars that this grammar calls, the grammars called by this grammar, and the depth of the grammar within the grammar calling structure. The RTN permits situation-action pairs to be strung together as a sequence of steps to take with possible decision points in the sequence. A Backus-Naur Form (BNF) specification is the syntax for defining the transition networks, 16:41-58; BNF notation is understood to provide an outline of rules for sentence structure and defining a format of a language, either in English or another natural language as well as a computer programming language). The logical schema {conversation mapping} using situation-action rules {the outline of sentence structure} and BNF notation rules {the information format} of Bloom would be used to generate natural language in the assessment item generator of Sweitzer, in order to abstractly define a set of possible discourses for readability and reuse. Bloom also teaches wherein determining an information format comprises determining an ordering of one or more elements for each sentence (the situation-action nodes of grammar form a path, 15:44-62). The mapping situation/action rules of the discourse grammar nodes of Bloom impart a logical order of a conversation, which the BNF notation rules of Bloom define an order to individual sentences. The rules of Bloom would be used to generate an assessment item in Sweitzer that improves readability and reuse of the item. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have produced a logical schema for use in the assessment item generator of Sweitzer, by outlining a sentence structure for one or more sentences, and determining an information format for each sentence, wherein determining an information format comprises determining an ordering of one or more elements for each sentence, as taught by Bloom, in order to abstractly define assessment item language for improved readability and reuse [Claims 29 & 30].

Art Unit: 3715

18. What Sweitzer further fails to teach is storing the logical schema in a file. However, Bloom teaches storing the logical schema in a file (each piece of multimedia is contained in separate files, 7:1-10). The logical schema stored in a file of Bloom would be used to generate an assessment item in the invention of Sweitzer, in order to format the assessment items of Sweitzer in natural language, using a reusable file. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the conversation generator as taught by Bloom, in the word problem generator of Sweitzer, in order to generate word problems that follow natural language, improving the reusability of the logical schemas by storing them in files. What Sweitzer and Bloom fail to explicitly teach is wherein the logical schema file is an XML file. However, Applicant has not disclosed that having the file be an XML file solves any stated problem or is for any particular purpose. Moreover, it appears that the Microsoft Word type files of Sweitzer (3:52-61) or the Applicant's instant invention would perform equally well for storing a variable document specification. Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have modified Sweitzer and Bloom to use an XML file, because such a modification would have been considered a mere design consideration, which fails to patentably distinguish over Sweitzer and Bloom.

19. What Sweitzer further fails to teach is wherein generating an assessment item comprises: parsing the logical schema; annotating the parsed logical schema with grammatical information; determining words and word forms based on the grammatical information; and outputting text representing the assessment item [Claim 33]. However, Bloom teaches wherein generating an assessment item comprises: parsing the logical schema (The conversation author is a tool that allows authors to create conversations based on specific paths through or parts of the developed discourse grammar. The conversation author works by having the author select



Art Unit: 3715

the grammar path, or part, to be instantiated. Next, they either select an existing conversation to edit, or else create and name a new conversation. Once the conversation is identified, they then execute the author functions, 19:60-62; designing and traversing the paths of the discourse grammar is understood to be parsing; also, parsing is also used to describe decoding a grammar using the Backus-Naur Forms); annotating the parsed logical schema with grammatical information (During authoring, the method and system of the present invention execute the selected grammar path, or part, and present the author with a variety of different input fields depending upon the specific situation or action being executed. In the case of "verbal situations", the author would type in the customer statement, request or question into the verbal situation input field. In the case of "operational situations", the author would type in the simulation situation input field, the name of the screen and field that the resulting action would take place in. In the case of implicit situations for which there is no overt clue, or situations in which information is to be given to the trainee unconditionally {cognitive actions}, the author would input the information in the situation input field, 19:66-20:3; the author's input of verbal, operational, or cognitive actions into the input fields is understood to be annotating the schema with grammatical information); determining words and word forms based on the grammatical information (In the case of verbal actions, the author would type in the correct response in the verbal action field, 20:13-15; a correct response would inherently be a grammatically correct response, else the author caused the response to be incorrect); and outputting text representing the assessment item (Once the conversation is complete, it is saved and automatically indexed according to its high level scenario, as well as by the specific sub-topics of conversation components that comprise it. The saved conversation can then be edited or else used by the system and method of the present invention, 20:23-29; saving is understood to be outputting the assessment item conversation to disk; using the conversation is understood to be outputting it to

Art Unit: 3715

a user). The specific steps of generating the assessment item using a logical schema, as taught by Bloom, would be used in the system and method of Sweitzer for generating a mathematical word problem, in order to provide authoring tools and automatic methods or a non-programmer instructional designer to easily generate the knowledge bases used to create the assessment items. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the method of Bloom to generate an assessment item, comprising parsing the logical schema; annotating the parsed logical schema with grammatical information; determining words and word forms based on the grammatical information; and outputting text representing the assessment item, in the method for generating an assessment item taught by Sweitzer, in order to provide authoring tools and automatic methods or a non-programmer instructional designer to easily generate the knowledge bases used to create the assessment items [Claim 33].

20. Sweitzer and Bloom teach all the features as demonstrated above in claim 10, including wherein the one or more inputs comprise one or more of: a number of events; a number of distinct frames; a type of participant in each event; and a type of assessment item to generate [Claim 10].

21. Claims 14, 15, 35-37, & 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweitzer and Bloom, and further in view of Wen.

22. Sweitzer and Bloom teach all the features as demonstrated above in claims 10 and 22. Bloom teaches wherein generating an assessment item comprises one or more of the following: selecting a sentence structure for each sentence in the assessment item (6:4-12, 15:54-57, and 19:48-53); selecting identification types for one or more of the variables; determining a numerical format for each of the one or more variables; and determining a verb tense to use for

Art Unit: 3715

each event [Claim 14]; a method of automatically generating an assessment item, the method comprising: assigning one or more mental model structure variables (a student model, 11:25-12:65); defining one or more identity variables for a mental model structure (application descriptions include information about input and output fields and the values expected in them, 16:9-13); determining a task-relevant problem structure (generating a list of events by traversing the nodes of the conversation tree, and binding the variables across the events, 16:9-13); defining a document format (conversations used to build a document structure using the user interface (4:17-20); and determining language variations (hierarchical patterns of vocabulary, 15:63-16:2) [Claims 35 & 41], including selecting a referent identification type for each of one or more participants (19:66-20:3) [Claim 41], wherein assigning one or more mental model structure variables comprises defining one or more of the following: one or more events (16:9-13); one or more distinct semantic frames; one or more participant types; and an event type for each event [Claim 36], wherein determining a task-relevant problem structure comprises: determining a variable for which to solve for each event (application descriptions include information about input and output fields and the values expected in them, 16:9-13); determining an answer for each event (10:46-51); and determining one or more values for each variable (The screen item describes an item of the screen and has a name by which it can be referred, a position and a size within the screen, and a default value. The value can be defined as a string or dynamically by a function, 17:31-37) [Claim 37], wherein determining language variations comprises: selecting a sentence structure for each of one or more sentences; selecting a referent identification type for each of one or more participants; and determining a tense for each of one or more events (17:48-18:7).

23. What Sweitzer and Bloom fail to teach is selecting a language for the assessment item [Claim 14]. However, Wen teaches a method and system of teaching a language, using a

Art Unit: 3715

grammatical engine which collects the grammar of a language {such as English} to provide grammatical rules (1:55-60). The grammatical engine of Wen identifies a language used to generate an assessment item, based on the grammatical rules, which would merely be a variable in the logical schema of Bloom, defining a particular set of Backus-Naur forms which parse a given language and define the natural language conversations taught by Bloom, used when generating the assessment item taught by Sweitzer. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used the grammar database identifying a language such as English, in Sweitzer's problem generator, in order to teach word problems while teaching a language [Claims 14, 15, 35-37, & 41].

24. What Sweitzer, Bloom, and Wen further fail to teach is wherein selecting identification types comprise determining to identify a variable denoting a person by using a proper name, wherein selecting identification types comprise determining to identify a variable denoting a person generically, wherein selecting identification types comprise determining to identify a variable denoting an object by using a label, wherein selecting identification types comprise determining to identify a variable denoting an object by using a description of the object [Claim 15]. However, Applicant has not disclosed that having proper names, generic names, labels and descriptions for persons or objects solves any stated problem or is for any particular purpose. Moreover, it appears that the variables of Sweitzer or the Applicant's instant invention would perform equally well for selecting identification types. Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the variable id's of Sweitzer, in combination with Bloom and Wen such that proper names, generic names, labels and descriptions for persons or objects identified variables, because such a modification would have been considered a mere design consideration, which fails to patentably distinguish over Sweitzer, Bloom, and Wen [Claim 15].

***Response to Arguments***

25. Applicant's arguments filed 1/21/2009 have been fully considered.

26. Applicant states that claims as amended are directed to statutory subject matter because the outputting of an item is patentable under 35 USC §101. However, the limitations of causing an output or other indication *to a user* that something has occurred are not found in claims 22-25 & 28-30. As such, the rejection is maintained for these claims. Additionally, method claims 7, 8, 10, 12-15, 22-25, 28-30, 33, & 35-37 merely recite a computer-implemented method in the preamble. It is not positively recited in the claimed steps what part of the computer performs each claimed step, and thus is interpreted that what is being claimed is a user having a computer perform the steps; for this reason, the claim fails to fulfill the requirements of *Comisky* and *Bilski* because user of the instant invention may infringe upon the claims by using the computer; therefore the rejections on these claims are maintained.

27. Applicant further argues at length that implicit support is found in the specification for not limiting the process of making and using the instant invention to any specific set of word problems, because a genus of problems is disclosed. Examiner maintains that enablement for examples of generating the specifically claimed types of problems, such as a distance-rate-time, interest rate computation, taxation, production, physics, or a fuel-efficiency problem is sparse at best; further it is not even clear what a taxation or production problem is. Nonetheless, the rejection of the claims under 35 USC §112 ¶1 is withdrawn, because Applicant appears to admit at page 7 where merely adapting the system of Sweitzer, in view of Bloom and Wen, to include a plethora of specific word problems would have been obvious to one of ordinary skill in the art at the time of invention, and not have required undue experimentation. Examiner agrees. As such, Applicant's further arguments at pages 7 & 8 that these minor variations are not merely non-functional descriptive material and design choices is unconvincing, because it would have

Art Unit: 3715

been obvious for a routineer in the art at invention time to have adapted the teachings of Sweitzer, Bloom, and Wen to fabricate any of the claimed word problem types in the manner taught.

### ***Conclusion***

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIKOLAI A. GISHNOCK whose telephone number is (571)272-1420. The examiner can normally be reached on M-F 11:00a-7:30p EST (8:00a-4:30p PST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3715

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4/18/2009

/N. A. G./

Examiner, Art Unit 3715

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715